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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 18  
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Tommy Hilfiger Licensing, Inc.

v.

William D. Smith, d/b/a Team Hawaii Sports

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Opposition No. 113,238  
to application Serial No. 74/703,279  
filed on July 19, 1995

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Louis S. Ederer and Debra Bodian Bernstein of Gursky & Ederer, P.C. for Tommy Hilfiger Licensing, Inc.

William J. Mason of Rhodes & Mason, PLLC for William D. Smith, d/b/a Team Hawaii Sports.

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Before Cissel, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

William D. Smith, d/b/a Team Hawaii Sports has filed an application to register the design mark shown below for "stickers" in Class 16; "T-shirts and golf shirts" in Class 25 and "surfboards" in Class 28.<sup>1</sup>

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<sup>1</sup> Serial No. 74/703,279, filed July 19, 1995, claiming a first use date and a first use in commerce date of May 1, 1993.

Tommy Hilfilger Licensing, Inc. has filed an opposition to registration of the mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act. In the Notice of Opposition opposer has alleged, inter alia, that opposer owns registrations for the marks TH and design,<sup>2</sup> TOMMY HILFIGER,<sup>3</sup> TOMMY HILFIGER (stylized),<sup>4</sup> TOMMY tommy HILFIGER (label),<sup>5</sup> Tommy box design<sup>6</sup> and TOMMY HILFIGER DIVISION 42 ATHLETICS;<sup>7</sup> that opposer, through its licensees has since 1984 been engaged in the manufacture, distribution and sale of all types of apparel and related accessories and since 1996 in the manufacture, distribution and sale of all types of cosmetic products; and that since

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<sup>2</sup> Registration No. 2,050,013, issued April 1, 1997.

<sup>3</sup> Registration No. 1,398,612, issued June 24, 1986;  
Registration No. 1,738,410, issued December 8, 1992;  
Registration No. 1,833,391, issued April 26, 1994;  
Registration No. 1,978,987, issued June 4, 1996;  
Registration No. 1,995,802, issued August 20, 1996;  
Registration No. 2,103,148, issued October 7, 1997;  
Registration No. 2,162,940, issued June 2, 1998.

<sup>4</sup> Registration No. 1,940,671, issued December 12, 1995.

<sup>5</sup> Registration No. 2,124,016, issued December 23, 1997.

<sup>6</sup> Registration No. 2,025,974, issued December 24, 1996.

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1985, opposer, through its licensees, has operated retail stores and retail store outlets. Opposer further alleges that it has used and promoted a family of TH marks in connection with its various products, including both the aforementioned TH mark and the marks THinsole, Thxtreme, T.H.A.W., Thermo, TH2O and THSkew; that as a result of extensive use of the initials TH alone and in combination with other terms on a wide variety of apparel and related accessories, the initials TH have become widely recognized by the public and the fashion industry as being synonymous with opposer; that the dominant portion of applicant's mark is TH, which would be likely to be understood by consumers as being part of opposer's TH family of marks; and that applicant's mark, when used in connection with applicant's goods, is therefore likely to cause confusion or cause purchasers to mistakenly believe that applicant's goods emanate from opposer or are sold under opposer's sponsorship.

Applicant, in his answer, has denied the salient allegations of the Notice of Opposition.

The Record

The record consists of the file of the involved application; opposer's testimony depositions, and accompanying exhibits, of Jade Huang, a Vice-President and

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<sup>7</sup> Registration No. 2,041,463, issued February 25, 1997.

associate counsel of Tommy Hilfiger U.S.A.,<sup>8</sup> Tracey Ann Tango, Director of Graphic Design for Tommy Hilfiger U.S.A., and Steven Gursky, an attorney representing opposer since March 1989; and, pursuant to opposer's request on consent to file evidence after the close of the testimony period, a copy of the file history for opposer's application Serial No. 75/975,631 and a copy of opposer's application Serial No. 74/459,720. Applicant has taken no testimony or offered any other evidence, except for a single exhibit made of record during the cross-examination of Ms. Huang. Both parties have filed briefs, but an oral hearing was not requested.

The Tommy Hilfiger company was formed in 1985, and at that time its primary market was men's sportswear. The company has grown rapidly since that time and has expanded, through a licensing program begun in the early 90's, into different apparel categories and accessories. The company's products now include apparel and accessories for men, women and children and, in addition, leather goods, home products and cosmetics. The net revenues of the company have grown from \$320 million in 1995 to \$1.63 billion in 1999. (Exhibit A). Since the early 90's the company has expended \$50 to \$75 million in advertising.

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<sup>8</sup> Tommy Hilfiger U.S.A. is the parent company and licensee of opposer. Opposer owns all the trademarks, patent brands and

The primary trademarks of the company are TOMMY HILFIGER, the flag logo, the crest design, the Tommy marks and the TH designation. The TH designation consists of the letters TH, but the letters are not used in any one particular style. (Huang deposition, p.12). Of all the labels, hang tags, prints, embroideries and so forth which carry a mark, approximately 25% of the designs reviewed for proposed use involve the designation TH, with 10% being used in connection with style names (names for a product) and 15% being used as the design on the actual garments or the packaging. There is no one consistent style of usage of the designation TH, but rather the letters appear in a number of ways. (Huang deposition p.24-25). One design used prior to 1991 was the T star H design, which is still in use today. (Tango deposition p.11-14). Other designs in use prior to 1995 include the T crest H, the T anchor H, the T golf club design H, and the TH laurel, as in the pleaded registration. One specific TH design shown to have been used on a shirt owned by Mr. Gursky for the past 12-13 years features the letter T with a slightly larger letter H adjacent thereto. Interlocking TH's have also been used, in varying forms, with at least the conception of such use dating back to 1992. (Tango deposition p.27,33). Other interlocking designs used in more recent years show the block letters TH

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intangibles of the Hilfiger brands, but Tommy Hilfiger U.S.A.

in varying positions, including the letter T superimposed over the letter H. (Exhibits E and V).

Opposer has also used the letters TH as part of a style name, such as THskew for a particular shoe style (Exhibit C-11), or TH as the base for word marks such as ThrmO, THAW, THextreme, TH2O and THinsolar to designate certain kinds of fabrics or textures in its garments. (Huang deposition p.40, Exhibits F and G).

Applicant has introduced no evidence other than a printout from the Office Website of applicant's mark. Applicant is accordingly limited for purposes of priority to the filing date of his application, July 19, 1995.

#### The Opposition

We look first to opposer's pleaded registrations for purposes of priority. Despite applicant's arguments that these registrations were not properly made of record, opposer introduced these registrations during the testimony of Ms. Huang (Exhibits K-1 and K-2) and thus the registrations are of record.<sup>9</sup> For the marks covered by the registrations, there is no question of priority, regardless of the issue date. See King Candy Co., Inc., v. Eunice

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handles all the intellectual property management issues.

<sup>9</sup> We note that in addition to the pleaded registrations, opposer introduced during testimony two other registrations, namely, Registration No. 2,286,255 for the mark TOMMY HILFINGER and Registration No. 2,304,661 for the mark TH SKEW. Although opposer also introduced several applications, these are irrelevant for purposes of priority, particularly when filed as intent-to-use applications.

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The more significant question is the relevance of the pleaded marks. Of these registrations we find only one which is pertinent to the use by opposer of TH marks, namely, Registration No. 2,050,013 for the TH and laurel design shown below for "shirts, hats, caps, pants, shorts, and socks":

The remainder of opposer's case rests in its common law usages of TH designations prior to the July 19, 1995 filing date of applicant's application. As shown by the record, these usages cover designations such as T star H, T crest H, T anchor H as well as the letters TH used in adjacent positions. The specific examples of record of the letter T superimposed over the letter H are all dated later than applicant's filing date.

Opposer's claim, however, is not simply to each of these individual designations and prior use thereof, but rather to the existence of a family of TH marks. As argued by opposer,

[t]he issue is not **when** Hilfiger commenced use of a **particular embodiment** of "TH" but whether Hilfiger's "TH" mark, which was originally used long before Applicant began using its mark, is so well-known

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to consumers that Applicant's usage is understood by consumers to be a Hilfiger usage. Even if the specific versions of "TH" used by Hilfiger before Applicant's filing date did not include an interlocked combination of "T" and "H", there is no doubt that because of Hilfiger's fame and position in the marketplace ( which has been conceded by Applicant).and its extensive use of "TH", both before and after Applicant commenced use, consumers would believe that apparel and related products bearing a "TH" originate from or are associated with Tommy Hilfiger. (Emphasis in original). (Reply brief, p.4).

Such an argument is clearly founded upon, and requires the proof of, the existence of a family of marks bearing the "TH" designation prior to the date to which applicant is entitled.

As stated by our principal reviewing court in J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991):

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

The need for evidence of promotion resulting in the recognition of the common characteristic of the family as an indicator of source by the purchasing public has been pointed out in Hester Industries Inc. v. Tyson Foods Inc., 2 USPQ2d 1645 (TTAB 1987), the Board stating:

... it is well settled that the mere ownership of a



number of marks sharing a common feature (or even ownership of registrations thereof) is insufficient to establish a claim of ownership of a "family" of marks characterized by the feature in the absence of competent evidence showing that prior to the first use by the alleged interloper, the various marks said to constitute the "family," or at least a goodly number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the "family" characteristic... .

In other words, as noted in *American Standard Inc. v. Scott & Fetzer Company*, 200 USPQ 457, 461 (TTAB 1978):

... it must be demonstrated that the marks asserted to comprise its "family" or a number of them have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

Opposer has failed, however, to produce any evidence which might demonstrate such promotion of its various TH designations in such a manner as to create common exposure of the public to the marks. While opposer may well have used a series of TH marks over the years, and many of these prior to the use by applicant of his mark, there is no evidence that opposer has promoted these marks together or has in any way referred to the marks as members of a family of marks owned by opposer. See *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527 (TTAB 2000).

Instead, opposer has adopted many different TH designs as its marks, as is readily apparent from the testimony of its witnesses as to the many designs they have reviewed over

the years. The series of varying designs, although all may have incorporated the letters TH in some manner, have clearly not been promoted as a family. There has been no use together, but rather just the opposite, one at a time. Thus, opposer has not established that it is entitled to claim a family of TH marks. Opposer has not established it has promoted and used its various TH marks in such a manner that the public would automatically equate the use of a design bearing the letters TH with a "Hilfiger usage." For the purpose of determining likelihood of confusion, our comparison is necessarily restricted to those TH marks for which opposer either owns a registration or has demonstrated use prior to the filing date of applicant's application, July 19, 1995.

Turning at this point to the issue of likelihood of confusion, we take under consideration all of the *du Pont* factors which are relevant under the present circumstance and for which there is evidence of record. See *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We look first to the specific marks of opposer falling within the bounds outlined above and applicant's mark and the similarities or dissimilarities thereof. Opposer's TH marks include the letters TH surrounded by a laurel design (the pleaded registration), the letters TH separated by various figures such as a star, an anchor or a crest, and

the letters TH alone adjacent to one another. We have no evidence of use prior to July 1995 of an interlocking design, particularly one in which the letter T is superimposed over the letter H.

Applicant describes his mark as being "essentially the design of a mask that incorporates vertically stacked and interlocked T and H to form a part of the mask design." (Brief, p.10). We find this to be an accurate description. While the letters T and H are clearly present, the overall commercial impression is much more than that of the letters alone. Although the letters may be viewed as a reference to Team Hawaii, nonetheless the entire impression created by the mark is greater, the mask design incorporating the letters being highly distinctive. Despite opposer's arguments and the testimony of its witnesses to the effect that the letters TH dominate applicant's mark, these letters cannot be considered to the substantial exclusion of the other features of applicant's mark. See *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990). The overall commercial impression created by applicant's mark is markedly different from that created by any of opposer's TH marks. It is in opposer's marks that the letters TH are clearly the dominant feature. The difference in overall commercial impressions of the marks of

opposer and applicant is a strong factor in applicant's favor.

Turning to the goods involved, we agree with opposer that there is overlap between opposer's wearing apparel and the T-shirts and golf shirts of applicant. As for the stickers of applicant, although we do not consider these the same as the hang tags and labels to which opposer likens the goods, we do consider such stickers well within the potential of promotional items which might be perceived by purchasers as emanating from opposer. The surfboards of applicant, on the other hand, do not fall within any such reasonable extension of opposer's wearing apparel. Although opposer has shown that in recent years it has expanded its swimwear goods to include a surfwear line and has sponsored a surf camp in California, we do not consider this a sufficient basis on which opposer can claim that applicant's surfboards per se reasonably lie within the natural expansion of opposer's wearing apparel business. See *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985).

No distinctions can be made between the channels of trade or potential purchasers for the goods of both. There being no restrictions in the application as to channels of trade, we must assume that the goods of applicant would travel in all the normal channels of trade, which would

encompass those of opposer. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

The other factor raised by opposer as being relevant here is the fame of the Hilfiger marks. From the statistics previously noted, it is clear that opposer's marks have achieved a strong degree of fame, particularly in the last five years. Applicant himself has acknowledged that TOMMY HILFIGER is a famous mark.

The issue in the present case, however, is the fame of the various TH marks which have been used by opposer. There is no breakdown of the sales and advertising figures by which we may attribute any certain percentage to the TH marks. From the testimony of Ms. Huang, the TH designation is present at the most in 25% of the proposed usages which she reviews. Thus, we have no basis on which to conclude that the TH designation in itself is a famous mark, particular since it is used in many different formats. We cannot conclude that the TH designation has attained such a level of recognition that this designation, regardless of the particular design in which it is used, is entitled to a broader than normal scope of protection.

Accordingly, on weighing the relevant factors, and particularly in view of the decidedly different commercial impressions created by the marks of the parties, we find no

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likelihood of confusion with the contemporaneous use by the parties of their respective marks.<sup>10</sup>

Decision: The opposition is dismissed.

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<sup>10</sup> Although opposer makes a major point of the examination history of applicant's application and the Examining Attorney's apparent unawareness that opposer's cited application later issued as a divisional application, we find this immaterial to our present decision. The evidence of record in this opposition is the determinative factor here.